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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,935	06/21/2001	Takao Kojima	IKEDA0033	3883

7590 09/09/2004

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EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/884,935

Applicant(s)

KOJIMA, TAKAO

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/21/2001</u> | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Priority*

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by  
Bezos Patent Application Publication US 2002/0178089.**

Referring to claim 1. Bezos discloses a preparing method for delivery request records, wherein, when a web server computer of a delivery consignee accepts a delivery request from a sender via a communication terminal, the computer sets one request record consisting of an appropriate number of necessary and reference items, automatically output a serial number of the parcel as a parcel ID item, and makes a receiver who can know the serial number to input and designate a delivery destination into said record by using the serial number as the ID key code (Bezos, paragraph 0015: "In one embodiment, the gift delivery system of the present invention receives gift

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orders via Web pages provided on the WWW. The gift orders specify a gift that is to be delivered to a recipient. The recipient may be identified by information that does not include the delivery address of the recipient. For example, the recipient may be only identified by a name and contact information such as an electronic mail address or a telephone number. The gift delivery system attempts to contact the recipient to obtain sufficient delivery information.”).

Referring to claim 2. Bezos further discloses a preparing method for delivery request records as set forth in claim 1, wherein the sender is made to input the receiver's e-mail address into the delivery request record, whereby the web server computer sends an e-mail to the receiver to inform him/her of at least the serial number of the parcel ID code and the server's URL (Bezos, paragraph 0016: “The gift order may specify contact information for the recipient, such as an electronic mail address or a telephone number of the recipient. Based on the contact information provided with the gift order, an attempt via electronic mail or an automated voice telephone call is made to initially contact the recipient and gather sufficient delivery information.”).

The Examiner notes, even though Bezos discloses all the limitations of claim 2, the contents of the e-mail address the computer sends to the receiver are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The e-mailing steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

Referring to claim 3. Bezos further discloses a preparing method for delivery request records, wherein, when a web server computer of a delivery consignee accepts a delivery request from a receiver via a communication terminal, the computer sets one request record consisting of an appropriate number of necessary and reference items, automatically outputs a serial number of the parcel as an ID item of the parcel (Bezoz: Figure 4, "**408**"), makes the receiver to input and designate a delivery destination, and makes a sender who can know the serial number to input a parcel collecting point into said record by using the serial number as the ID key code (Bezoz: paragraph 0021 through paragraph 0022).

Referring to claim 4. Bezos further discloses a preparing method for delivery request records as set forth in claim 3, wherein the web server computer makes the receiver to input the sender's e-mail address into the delivery request record, whereby the computer sends an e-mail to the sender and informs of at least the serial number of the parcel and the server's URL (Bezoz, paragraph 0015 through paragraph 0018).

Referring to claims 5 and 7. Bezos further discloses a web server computer to be used to carry out the method of claim 1 or 3 (Bezoz: Figure 2, "**201**").

Referring to claims 6 and 8. Bezos further discloses a communication terminal of an agent of a delivery consignee, which is used to carry out the method of claim 1 or 3 (Bezoz: Figure 2, "**207**").

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

De Sylva, Patent Application Publication US 2004/0153357 A1, August 5, 2004, discloses a system and method for facilitating interaction between participants in a transaction.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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MSG

August 31, 2004